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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert J. Laferriere et al.	§	Group Art Unit:	3715
Serial No.: 09/682,238	§	Examiner:	Saadat, Cameron
Filed: August 8, 2001	§		
For: PLATFORM INDEPENDENT TELECOLLABORATION MEDICAL ENVIRONMENTS	§	Atty. Docket:	GEMS:0136/YOD/SWA/EUB 15-SV-5654

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July 5, 2006 — Date
L. Lee Eubanks IV

REPLY BRIEF PURSUANT TO 37 C.F.R. §41.41

This Reply Brief is being filed in response to the Examiner's Answer mailed on May 5, 2006. Specifically, with respect to the sole ground of rejection previously presented by the Examiner during prosecution and addressed in Appellants' Appeal Brief, this Reply Brief addresses the Examiner's attempt to reach the presently claimed subject matter through provision of a new interpretation of the Slattery et al. reference and the instant claims. *Compare* Examiner's Answer mailed May 5, 2006, page 12 (in which the Examiner argues that the second computing system controls a pod controller 24, and that the pod controller 24 is part of both the first and second computing systems) *with* Advisory Action mailed August 30, 2005, page 2 (in which the Examiner argues that the second computing system controls the student terminal 12 of the first computing system). Additionally, this Reply Brief also addresses a new ground of rejection, applicable only to independent claim 16, provided in the Examiner's Answer. *See* Examiner's Answer mailed May 5, 2006, pages 8-9.

In the interest of brevity, Appellants will generally endeavor to address only those issues or arguments raised in the Examiner's Answer which are particularly noteworthy. Accordingly, because Appellants will attempt to avoid repetition in this Reply, Appellants respectfully request that the Board carefully consider the arguments set forth in the previously filed Appeal Brief.

New Interpretation of the Slattery et al. Reference

First, Appellants note that the Examiner has waited until the filing of the Examiner's Answer to set forth a new interpretation of the Slattery et al. reference and the present claims. Particularly, while Appellants had repeatedly noted that each of the trainee and mentor computing systems of the Slattery et al. reference could control pod controller 24, at no point during prosecution did the Examiner even hint that he for some reason believed that, as he now argues, the pod controller 24 could be considered part of the trainee (or first) computing system recited by the instant claims. Further, even ignoring the Examiner's substantially delayed reinterpretation of the cited reference and present claims, the Examiner's present interpretation would not be shared by one skilled in the art.

Appellants respectfully note that, during patent examination, the pending claims must be given an interpretation that is *reasonable* and *consistent with the specification. See In re Prater*, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *see also In re Morris,* 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); *see also* M.P.E.P. §§ 608.01(o) and 2111. Moreover, any interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *See In re Cortright*, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); *see also* M.P.E.P. § 2111. Additionally, while limitations from the specification cannot be read into the claims, "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim is a quite different thing from 'reading limitations of the specification into a claim ....'" M.P.E.P. § 2111, *In re Prater*, 162 U.S.P.Q. at 550-51.

Appellants certainly appreciate the difficulty faced by the Examiner in interpreting the claims in view of the specification without improperly importing limitations from the specification into the claims. However, Appellants respectfully note that the Federal Circuit, sitting *en banc*, recently provided a summary and additional guidance regarding the proper interpretation of claims in view of the specification. *See Phillips v. AWH Corp.*, No. 03-1269, -1286 (Fed. Cir. 2005). In *Phillips*, the Federal Circuit again emphasized the primacy of the specification in claim interpretation. Particularly, the *Phillips* court noted that the specification "is always highly relevant to the claim construction analysis. Usually, it is dispositive; *it is the single best guide to the meaning of a disputed term.*" *Phillips*, slip op. at 13 (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)) (emphasis added). Moreover, the court also noted that:

> Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. The construction that stays true to the claim language *and most naturally aligns with the patent's description of the invention* will be, in the end, the correct construction.

Phillips, slip op. at 15 (quoting *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)) (emphasis added).

In view of this binding legal precedent, Appellants respectfully submit that the claim interpretation provided in the Examiner's Answer mailed May 5, 2006, extends beyond the broadest reasonable interpretation that would be afforded the claims by one skilled in the art in view of the specification.

As noted in the Appeal Brief filed December 12, 2005, the Slattery et al. reference is generally directed to computer based training. Col. 1, lines 31-34. Notably, the Slattery et al. system includes a pod controller 24 for controlling a pod 26 that comprises one or more devices 40. Col. 3, lines 44-46; *see also* Figs. 1, 2, 3, 9, 10. The pod controller 24 includes a user communications module 304 that allows a user to connect to

a device 40 via a user or student computer 28 or 1010 (or via the computing equipment or system 12 located on a customer's premise) and a mentor communications module 306 that allows a mentor to monitor a student's control of a device 40, as well as allowing the mentor to independently control the device 40 for the user or student to monitor during a learning exercise through equipment 906 or instructor terminal 1012. Col. 4, lines 10-21; *see also* col. 7, line 40 – col. 8, line 32. In other words, the student and mentor can *watch* each other *separately control* the device 40. *See id.*

Further, the Slattery et al. reference also discloses software that allows two users to collaborate (i.e., monitor *separate* control) over a network while interacting with a single program. Col. 7, lines 54-60. The reference states that the pod controller 24 may also include a wiretap 902, which allows a mentor to monitor the instructions the user is sending to a device 40 to ensure that the user or student is properly controlling the device. Col. 7, lines 40-54. Wiretap 902 permits the mentor to take control of the device 40 and allows the student to watch the instructions the mentor is sending to the device 40. Col. 7, line 65 – col. 8, line 5. It should again be noted, however, that in the Slattery et al. system, the mentor and the student computers each *separately* control a device 40. The mentor computer *does not* control a device 40 *through the student computer*.

In sharp contrast, the present application discloses, among other things, various embodiments in which a medical diagnostic imaging system is operated by a first, controlled computer system, and in which a second, controlling computer system may also operate the medical diagnostic imaging system through control of the first computer system. For instance, with respect to one embodiment, the specification explicitly states that a first, *controlled computer system* 12 is coupled to a medical diagnostic imaging system 84, which includes a system controller 88. Application, page 12, paragraph [0034]; FIG. 6. The specification also states that, in this embodiment, a second, *controlling computer system* 14 can be linked to the first, controlled computer system 12 via a network 36 to allow the second (controlling) computer system 14 to execute commands on the first (controlled) computer system 12 and to thereby control the

imaging system 84 (via the system controller 88). *See id.*; *see also, e.g., id.* at page 10, paragraph [0030]; FIG. 4.

In the Examiner's Answer, the Examiner equated both the customer system 12 and the pod controller 24 of FIG. 9 of the Slattery et al. reference with the first (controlled) computing system operated by the trainee, as recited in claim 16. *See* Examiner's Answer, page 12. The Examiner also equated the mentor system 906 and the pod controller 24 with the second (controlling) computing system recited in claim 16. *See id.* Thus, in the Examiner's updated interpretation, the pod controller 24 is part of both the first and second computing systems. While Appellants recognize that this interpretation may comport with a "broadest *possible* interpretation" standard, it extends well beyond the actual legal standard of broadest *reasonable* interpretation that would be reached by one skilled in the art in view of the specification. *See supra*, page 3 (noting the important role the specification plays in claim interpretation).

Even when considered in a vacuum, there is no support for the Examiner's contention that pod controller 24, which is remote from the computer system 12, would be considered to be part of the same computer system. However, as noted above, the present specification explicitly denotes a medical diagnostic imaging system 84 that includes a system controller 88, and that a first (controlled) computing system 12 is used to control the imaging system 84 and controller 88. *See* Application, page 12, paragraph [0034]; FIG. 6. In other words, the specification clearly describes the first (controlled) computer system as being independent of, i.e., not including, the system controller 88 (which is instead described as a portion of imaging system 84).

In the Slattery et al. apparatus, the computing system 12 similarly controls a pod controller 24 and device pod 26. *See* FIG. 1. Appellants respectfully note that pod controller 24 of the Slattery et al. reference serves much the same function (controlling the device pod 26) as system controller 88 of the present disclosure (controlling the scanning apparatus 86). Consequently, Appellants respectfully submit that the

Examiner's equating of the claimed first, controlled computer system with the computer system 12 *and* pod controller 24 of the cited reference is both directly contrary to the discussion of the recited elements in the specification and inconsistent with the interpretation that would be reached by one skilled in the art in view of the specification. For reasons that are obvious in view of numerous Federal Circuit cases, including *Phillips*, *Renishaw*, and *Vitronics*, the Examiner's interpretation, which is in direct opposition to the specification, cannot be sustained. For at least these reasons, in addition to those outlined previously in the Appeal Brief filed December 12, 2005, Appellants respectfully submit that the Slattery et al. reference, even in hypothetical combination with the Ross et al. reference, fails to support a *prima facie* case of obviousness with respect to any of the pending claims.

As an alternative argument, the Examiner suggests that Slattery et al. disclose a mentor computer system 906 that "controls" a customer computer system 12 simply because the customer computer system 12 can observe (via wiretap 902) the mentor computer system 906 controlling a device in pod 26. *See* Examiner's Answer, pages 12-13; Slattery et al., FIG. 9. As a preliminary matter, this assertion only appears to be applicable to the recitation of "controlling the first computing system via the second computing system" in independent claim 16. This interpretation, however, appears to be based on equivalence between "control" and "observe." The mere fact that wiretap 902 allows a user or trainee to use their own computer system to *watch* a mentor system control a device in pod 26 cannot be reasonably interpreted as the mentor system *controlling* the trainee system. By way of analogy, in a traditional classroom, a student may watch a teacher solve a math problem on a chalkboard. While the teacher does control the content of instruction (i.e., the steps taken to solve the problem and the manner in which these steps are displayed on the chalkboard), no reasonable person would argue that the teacher is "controlling" the student by writing on the chalkboard. Similarly, the present wiretap 902 of the Slattery et al. reference allows a student to watch a mentor control a device of the pod 26. However, the mentor system 906 does not execute any commands or otherwise exert control on the customer system 12 to operate

devices in the pod 26. As such, any assertion that the mentor system 906 "controls" the customer system 12 simply because a customer can watch the mentor control a different device is wholly without merit.

As discussed above, the Examiner's new interpretations of the instant claims and the Slattery et al. reference are contrary to the interpretation that would be afforded by one of ordinary skill in the art in view of the present specification. Further, as the interpretation reached by the Examiner is directly contrary to that which would be reached by one skilled in the art, it appears that the new interpretations are actually based on nothing more than hindsight reasoning. *See In re Gorman*, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991) (stating "it is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, *using the applicant's structure as a template* and selecting elements from references to fill the gaps" (emphasis added)). Accordingly, the Examiner has, at best, employed impermissible hindsight reconstruction to reject the instant claims. That is, it appears that the Examiner has used the structure of Appellants' invention as a basis from which to selectively pick and choose various elements of the cited references in an attempt to cobble together obviousness rejections of independent claims 16, 28, and 34. This hindsight reconstruction is improper, the Examiner has failed to properly interpret the claims in a reasonable fashion in view of the specification, and the present obviousness rejections of the instant claims cannot stand.

For at least the reasons provided above and in the Appeal Brief filed December 12, 2005, Appellants respectfully request withdrawal of this rejection under 35 U.S.C. § 103 and allowance of claims 16-42.

New Ground of Rejection

Appellants respectfully urge the Board to review and reverse the Examiner's new ground of rejection in which the Examiner alternatively rejected claim 16 under either 35 U.S.C. §§ 102(b) or 103(a) as anticipated by U.S. Patent No. 5,684,952 to Stein ("the Stein reference"), or unpatentable over the combination of the Stein and Ross et al.

references. For at least the reasons provided below, Appellants respectfully traverse these alternative rejections.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Moreover, the prior art reference also must show the *identical* invention "*in as complete detail as contained in the ... claim*" to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Appellants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

Appellants also note that the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Omitted Features of Independent Claim 16

Turning now to the present claims, the Stein reference fails to disclose each element of independent claim 16. For instance, independent claim 16 recites "interactively instructing the trainee via the collaborative computing environment, wherein interactively instructing the trainee includes controlling the first computing system via the second computing system *in an operating system-independent manner*" (emphasis added). Because the Stein reference fails to disclose such an element, the cited reference fails to anticipate or support a *prima facie* case of obviousness with respect to independent claim 16.

In the Examiner's Answer, the Examiner asserted that Stein discloses interactively instructing the trainee by controlling a first computing system via a second computing system in an operating system-independent manner. Appellants respectfully note that the only support provided by the Examiner with respect to the operating system-independent manner of control recited in claim 16 is a citation to col. 7, lines 4-6, of the Stein reference. Appellants respectfully note that this passage of Stein merely states:

> Keystrokes and cursor actions that are input at the teacher's workstation are transmitted to the selected workstation, so that both the selected workstation and the teacher's workstation are controlled by the teacher.

Stein, col. 7, lines 4-7. The Examiner alleged that this passage teaches control in an operating system-independent manner because "the operating system of the teacher controls the student workstation independent of any control of the operating system of the student workstation." Examiner's Answer, page 9. Appellants respectfully disagree with this assertion.

First, Appellants do not necessarily believe that the Examiner's interpretation of the "operating system-independent manner" element of independent claim 16 would be shared by one skilled in the art in view of the present specification. *See, e.g.*, Application, page 5, paragraph [0018]; *id.* at page 7, paragraph [0023]. Appellants respectfully note, however, that even assuming for the sake of argument that the

Examiner's interpretation of the recitation "operating system-independent manner" is correct, the assertion that Stein discloses controlling a system in such a manner is not supported by the passage on which the Examiner relies. In particular, the passage does not state or suggest that control by the teacher workstation is independent of the selected (student) workstation. In fact, in what appears to be one of few substantive examples, the Stein reference discloses that such control may be initiated to launch files on the student workstation from the teacher workstation. Col. 10, lines 53-58. Particularly, in the context of launching a file, the cited reference explicitly provides a workflow of the student workstation, in which the student (slave) computer performs file searches (steps 1306, 1314, and 1322), sends an error message to the teacher computer (step 1310), and/or launches a program (steps 1320 and 1326) in response to a launch request from the teacher (master) computer. *See* col. 12, line 50 – col. 13, line 8 ("The flowchart of FIG. 13 depicts the operations that are carried out *at the students' workstation* in response to a [teacher] command to launch a file" (emphasis added)); FIG. 13. It would appear that, as the workflow is carried out by the student computer, the operating system of the student computer is involved in the control process, directly contrary to the Examiner's assertion. As such, the Stein reference does not appear to disclose "controlling the first computing system via the second computing system in an operating system-independent manner." Accordingly, the Stein reference fails to anticipate independent claim 16. Additionally, the Examiner's assertions with respect to the Ross et al. reference fail to obviate the deficiencies of the Stein reference. Consequently, the Stein and Ross et al. references fail to establish a *prima facie* case of obviousness with respect to claim 16.

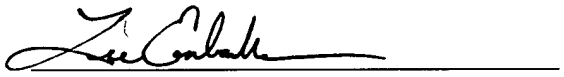
For at least these reasons, Appellants respectfully request withdrawal of the new alternative rejections of independent claim 16 under 35 U.S.C. §§ 102 and 103 and allowance of claim 16.

Conclusion

In view of the above remarks, Appellants respectfully submit that the Examiner has provided no supportable position or evidence establishing the anticipation of claim 16 or a *prima facie* case of obviousness with respect to claims 16-42. Consequently, Appellants respectfully submit that all pending claims are in condition for allowance. Accordingly, Appellants respectfully request that the Board withdraw the improper rejections of claims 16-42 and that the Board direct the Examiner to allow the instant claims. However, if the Examiner or Board wishes to resolve any other issues by way of a telephone conference, the Examiner or Board is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: July 5, 2006



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